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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,078	07/09/2004	Urs Burckhardt	120346	3301
25944	7590	05/30/2006	EXAMINER	
OLIFF & BERRIDGE, PLC			YAO, SAMCHUAN CUA	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	

1733
DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/501,078	Applicant(s) BURCKHARDT ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17-19 are indefinite, because it is unclear what element/object is being contacted by the recited composition.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichel et al (US 6,103,850) in view of JP 2000297136 A.

With respect to claims 1, 3, 14, 22-23, and 25-28, Reichel et al discloses a single-component moisture curable sealant/adhesive composition, the composition comprises an NCO terminated polyurethane prepolymer, which is a reaction product of an organic polyisocyanate and polyols made of at least a linear polyoxyalkylene polyether polyol; and an amine type of curing/chain-extending agent; wherein the polyoxyalkylene polyether polyol has a "degree of

unsaturation of 0.06 meq KOH/g of polyol or less" (emphasis added; abstract; col. 3 line 55 to col. 4 line 63; col. 5 lines 1-33; col. 10 lines 1-30; col. 14 lines 54-67; col. 15 line 1 to col. 16 line 67).

While Reichel et al teaches using polyamine as a curing/chain-extending agent, Reichel does not teach using a polyaldimine curing agent. However, it would have been obvious in the art to use a polyaldimine curing agent in formulating a composition of Reichel et al, because JP '136, drawn to a type of polyurethane composition which is similar to the one suggested by Reichel et al (i.e. a one-part moisture curable polyurethane composition comprising a NCO terminated urethane prepolymer), discloses using a polyaldimine as "*the most desirable*" curing agent for this type of polyurethane composition, wherein the polyaldimine is hydrolyzed to generate an amine and cure the NCO terminated urethane prepolymer (English abstract).

With respect to claims 2 and 24, see column 4 lines 37-48 and column 14 lines 54-63 of the Reichel patent, where an equivalent weight of polyether polyols is at least 1500 (hence, for a functionality of 2, the molecular weight is at least 750).

With respect to claim 4, see column 12 lines 33-50 of the Reichel patent.

With respect to claim 5, see abstract; column 1 lines 9-17 and column 7 lines 22-44 of the Reichel patent.

With respect to claims 6-8, as noted above, Reichel patent teaches using polyoxyalkylene polyol with a degree of unsaturation which is less than 0.06 meq/g and an equivalent weight of at least 1500. Also see abstract, column 1

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lines 19-31 and column 6 line 57 to column 7 line 15 of the Reichel patent for the functionality of a polyol component. Since: a) it is now well settled that "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same very same purpose ..." (MPEP 2144.06), and b) it is well within the purview in the art to apply a blend from within a workable composition range suggested by a prior art reference, claims 6-8 would have been obvious in the art.

With respect to claim 9, see column 6 lines 34-56 of the Reichel patent.

With respect to claim 10, see column 18 lines 37-63 of the Reichel patent.

With respect to claims 11 and 13, the limitation in claim 11 is an art recognized effective way for making a polyaldimine from an aldehyde and an amine.

Moreover, a preference on whether to form a polyaldimine or to use an existing polyaldimine (i.e. buying a commercially available polyadimine) is taken to be well within the purview of choice in the art. For these reasons, these claims would have been obvious in the art.

With respect to claim 12, see column 19 lines 4-57 of the Reichel patent.

With respect to claims 15-19 and 28, since it is a notoriously common practice in the art to use an applicator such as an injection device, spraying device, extruding device for applying this type of polyurethane composition in order to effectively apply the polyurethane composition of Reichel to a substrate in order to form an adhesively bonded article or a sealed article, these claims would have

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been obvious in the art. Also see column 15 lines 26-55 for applications of the composition for making various articles.

With respect to claim 20, since ambient air intrinsically contains some moisture, it is a notoriously common practice in the art to subject a moisture curable composition to an ambient air. For this reason, this claim would have been obvious in the art as such is an effective and yet a cost free way to cure the moisture curable adhesive of Reichel et al.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 2 as applied to claim 17 above, and further in view of Pfenninger et al (US 6,136,942).

Since Pfenninger et al, drawn to a type of an adhesive/coating composition which is similar to a composition taught by Reichel et al (i.e. single part moisture-curable polyurethane) discloses using this type of adhesive or coating on a fir-wood (taken to a hydrous component since it intrinsically contains at least to a certain degree some moisture; examples 9-10), this claim would have been obvious in the art. More importantly, one in the art would have readily recognized and appreciated that a moisture curable composition of Reichel et al would be most suitable for components which are hydrous, because the moisture within each hydrous component would help the curing rate the composition and also obviate the need for external application of moisture to the composition for curing.

Response to Arguments

6. Applicant's arguments with respect to claim 1 has been considered but are moot in view of the new ground(s) of rejection.


Conclusion

In light of a new ground of rejection, this office action is made NON-FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richard Crispino can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
05-15-06